

### **III. REMARKS**

Claims 1-4, 7-8, 15, 19-20, 22 and 24 were rejected under 35 U.S.C. 103 as being unpatentable over Ejzak (US 6,721,565) in view of Lautenschlager (US 6,321,096) and Valentine (US 6,081,510), and Claims 5-6, 9-14, 16-18, 21 and 23 were rejected under 35 U.S.C. 103 as being unpatentable over Ejzak in view of Lautenschlager, Valentine and Forslow (US 2003/0039237) for reasons set forth in the Office Action.

The claims are amended to state that the messages are text-based messages to distinguish the claims further from the teachings of the cited art. The feature of a text-based short message is presented in original claim 5.

The following argument is presented to overcome the foregoing rejections, and to show the presence of allowable subject matter in the claims.

Ejzak does not teach a procedure for initial message transmission with network selection determining if the message is to be transmitted to a circuit-switched network or a packet-switched network, triggered in response to the need to transmit a message. The Ejzak reference is about handovers. It states in passages cited by the Examiner and elsewhere that a precondition for a handover to occur is that a stable call is ongoing, see Col. 14, lines 13-14 and 18-19. Stable calls are also the starting point of all four scenarios listed in the Summary of the Invention part, namely Col. 4, at lines 25-39, 40-52, 53-64, and line 65 through line 6 of column 5. Furthermore, Col. 5, at lines 7-8, states that these scenarios are all the possible combinations foreseen by Ejzak. An understanding of the stable call requirement is provided by Ejzak also at element 714 (Fig. 7), element 814 (Fig. 8) and element 916 (Fig. 9). The existence of a stable call is also required by Ejzak for the mobile-assisted handoff, since the mobile terminal reports measurement results to the network, Col. 11, Lines, 45-47. According to Ejzak, the network instructs the mobile to start using another system, see figure elements 718, 818 and 918 of Figs. 7, 8, and 9, respectively. If there would be no

stable call, the mobile could not be instructed by the network to start using another system and the system of Ejzak would not work. For the above reasons, and also the ones submitted in prior responses, the handover related features of Ejzak are not relevant for the presently claimed features related to message transmission.

Furthermore, Ejzak in Col. 14, at Lines 35-37 (cited by the examiner), states that it is the system that determines that a handover is needed, not the terminal. In contrast, Lautenschlager (Abstract, and Col. 2 at lines 20-24) states that the mobile would switch over to another network on its own initiative. This contradicts the teaching of Ejzak, wherein the network directs a mobile to handover, such that the teachings of Lautenschlager and Ejzak are incompatible, and cannot be combined.

It should also be pointed out that Lautenschlager, like Ejzak, are both silent on the concept of attachment to a network providing packet-switched services, and fails to disclose the currently claimed features related to attachment. The term "attachment" is described in the present specification (page 2 at lines 1-3), which presents an example of attachment and states: "The attachment of an MS to a SGSN refers to the formation of a mobility management context for the MS, this function being called GPRS Attach in the GPRS system." This should not be confused with a situation wherein a mobile station is inside a specific coverage area, as may be defined by RF signal strength, because the location of a mobile station within the coverage area does not determine the state of "attachment". A coverage area may have signals from plural communication networks operating under different protocols, such that the mobile station might be attached to one of the networks while being detached from a second of the networks. It is urged respectfully that the teaching of Lautenschlager is being misapplied to the present claims because a person skilled in this art would appreciate that attachment to a packet network is not the same thing as being inside a coverage area, as defined by RF field strength. Therefore, the cited RF measurements of Lautenschlager are not relevant as regards the currently claimed checking of attachment to a network providing packet-switched services.

Furthermore, both of Lautenschlager and Ejzak fail to teach such checking of a status attachment to a network providing packet-switched services in response to a need to transmit a message.

Valentine describes a system where a "far-end modem" is sent a message (called an error message by the examiner) advising it to cease data transmission temporarily (see Col. 1, Line 65 – Col. 2, Line 9) until a "resume" message is received, see Col. 4, Lines 19-21, due to adverse radio-link conditions. This is difficult to reconcile with the requirement in Ejzak of an ongoing "stable call", and it is unclear how the modem which has been instructed to stop communicating could send the "mobile-assisted handover" measurement reports, see Ejzak Col. 11, Lines 45-47 and Page 3, line 1 of the office action. Thus combining Valentine with Ejzak destroys the function of Ejzak used in the present rejection, which thus may be regarded as improper so that the rejection should be withdrawn. A reference is made to *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the present specification (page 2 at lines 15-30), the issue is raised as to whether a network can support a particular format of communication. For example a communication system that does not support the short message service (SMS) will fail to communicate such a message even though there is optimum signal to noise (SNR) power ratio. The specification (page 3 at lines 8-15) discusses two signal formats, namely, the packet switched network and the SMS. One can switch between networks (lines 16-32) to obtain a desired communication. This discussion in the specification applies to communication links operating at high SNR with good quality signals. Therefore, the examiner's analogy with network switching based on the criteria of adequate SNR tends to negate the significance of the claimed step of checking if the mobile station is attached to the second network.

Furthermore, even if Valentine would be considered, Valentine merely teaches that the data transmission is interrupted until a resume message is received, and then resumed after reception of the resume message. Also, upon combining the teachings of Forslow with the teachings of Valentine, Ejzak and Lautenschlager, the foregoing analysis still applies. Accordingly, the foregoing argument applies to overcoming all of the claim rejections, and also shows the presence of allowable subject matter in the rejected claims as well as in the newly presented claims. Accordingly, there would be no motivation to combine the foregoing references to support the rejection under 35 U.S.C. 103.

As regards the Ejzak et al, Ejzak, considered alone and in combination with Lautenschlager, does not teach triggering of a handover in response to the need to transmit one of the packets. Instead, a handover is triggered in response to the criteria mentioned in column 11, lines 39-41, which by way of example include poor quality signal path, load balancing among neighboring cells, as well as administrative and policy reasons. The mobility management context, which is a subject of the claimed step of checking if the mobile station is attached to the second network, is not suggested among the examples of Ejzak.

Furthermore, the mobility management context, which is a subject of the claimed step of checking if the mobile station is attached to the second network, is a valid basis for requesting (in claim 1 and other ones of the independent claims) communication via the circuit-switched services rather than the packet-switched services even if there is a strong signal transmission provided by the packet-switched services.

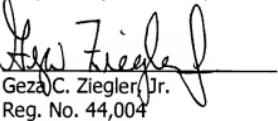
The present invention is directed to a problem in systems having both packet-switched networks that support a transferring of messages, for instance GPRS networks supporting transfer of SMS text-based short messages, and other packet-switched networks that do not support a transferring of such messages. In these situations the terminal (mobile station) does not know if the current packet-switched network supports the transfer of

such messages. The present invention provides for a selection of a communication network and a message transfer procedure that enables transmission of text-based messages, which are intended to be transmitted via a packet-switched network, to be transmitted also in systems that do not support short message transmission via a packet-switched network (present specification on page 3 at lines 8-15).

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
\_\_\_\_\_  
Geza C. Ziegler, Jr.  
Reg. No. 44,004

15 JAN 2008  
Date

Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800  
Customer No.: 2512

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this correspondence is being transmitted electronically, on the date indicated below, addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 15 January 2008

Signature: Frances Snow  
Frances Snow  
Name